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09/750,001	12/29/2000	Scott M. Frank	BS00-428	6605

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EXAMINER	
OUELLETTE, JONATHAN P	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,001	FRANK ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *53-109* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *53-109* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *20050916*.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 11/2/2005 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/750,001 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. Claims 1-52 have been cancelled and Claims 53-109 have been added; therefore Claims 53-109 are currently pending in application 09/750,001.

Priority

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional applications (60/173919, 60/192862) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claim 53, 64, 75, 86, 92, and 98 of this application. The provisional applications fail to disclose "tracking data related to a plurality of *non-monetary* innovation awards." The provisional applications also fail to disclose "determining participation data for each of a plurality of innovator classes."

Claim Rejections - 35 USC § 112

4. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 53, 64, 75, 86, 92, and 98 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

6. **Independent Claims 53, 64, 75, 86, 92, and 98** describe a utilization system which determines how the intellectual property asset should be utilized based upon intellectual property licensing rights marketability data, wherein the determining includes generating an intellectual property licensing rights marketing opportunity assessment.

7. However, the specification does not describe a marketing opportunity assessment as part of the IP Utilization System (Utilization based on initial valuation of IP asset – objective and subjective standards, pg.48 of specification), but rather describes a marketing opportunity assessment that is part of the IP Marketing System (Fig.212; pg.63 of Specification, IP marketing opportunity scoring module) - which is used once the decision to "Market" is made by the Utilization System (Fig.5). The applicant has combined the two separate systems (IP Utilization System [7000] and IP Marketing System [9000]) in the independent claims, to create one all-encompassing system, which is not fully disclosed or described in the specification.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. **Claims 53, 54, 58, 64, 65, 69, 75, 76, 80, 86, 92, 98, and 104-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (US 6,298,327) in view of Eggleston et al. (US 6,061,660).**

10. As per **independent Claims 53, 64, 75, 86, 92, and 98**, Hunter discloses a computer-readable medium containing a program for use with a computer (apparatus, method) for tracking innovations as part of a system for managing protection and licensing of intellectual property assets, the program comprising the steps of: receiving intellectual property asset protection data (inventive disclosure), wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets, wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception), wherein the intellectual property asset protection data further includes data related to a plurality of innovation disclosures, each innovation disclosure associated with one of a plurality of innovators; storing the intellectual property asset protection data in an intellectual property asset protection

database including a plurality of intellectual property asset protection data records; providing information from at least one intellectual property asset protection data record in the intellectual property asset protection database corresponding to at least one intellectual property asset to an intellectual property utilization system; and determining by the intellectual property utilization system how the intellectual property asset should be utilized based upon intellectual property licensing rights marketability data (C9 L15-17), wherein the determining includes generating an intellectual property licensing rights marketing opportunity assessment (marketability evaluation) for at least one intellectual property asset corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database (C2 L43-54, C5 L39-44, C8 L11-17, Determine whether to Patent (US, EPO, JPO) the technology (utilization of inventive disclosure) or not based on a patentability assessment and marketability evaluation).

11. While Hunter does disclose tracking innovations, inventors, and inventor related information (C11 L48-57, C18 Table 3), Hunter fails to expressly disclose wherein the storing includes a step of tracking data related to a plurality of non-monetary innovation awards, each innovation award associated with at least one of the innovation submissions.
12. Eggleston discloses the creation of employee incentive programs, which include tracking/automated fulfillment of non-monetary reward distribution data (Fig.20, C8 L13-20, C31 L25-67, C32 L1-20).
13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the storing includes a step of tracking data

related to a plurality of non-monetary innovation awards, each innovation award associated with at least one of the innovation submissions, as disclosed by Eggleston in the system disclosed by Hunter, for the advantage of providing a method for tracking innovations awards with the ability to increase effectiveness of the system by offering/tracking a multitude of award types.

14. As per Claims 54, 65, and 76, Hunter and *Eggleston* disclose wherein the tracking step further comprises: tracking the distribution of one of a plurality of gifts given to one of the plurality of innovators as the non-monetary innovation award.
15. As per Claims 58, 69, and 80, Hunter and *Eggleston* disclose wherein the tracking step further comprises: generate a form letter (coupon sheet, points announcement) associated with one of the innovation awards.
16. As per Claims 104, 105, and 106, Hunter and *Eggleston* disclose tracking data related to a plurality of non-monetary innovation awards, each innovation award associated with at least one of the innovation submissions, so that award costs and inventory can be effectively tracked and managed.
17. As per Claims 107, 108, and 109, Hunter discloses determining participation data for each of a plurality of innovator classes, so that participation rates can be effectively tracked and managed.
18. **Claims 55-57, 59-63, 66-68, 70-74, 77-79, 81-85, 87-91, 93-97, and 99-103 are rejected under 35 U.S.C. 103 as being unpatentable over Hunter in view of Eggleston.**
19. As per Claims 55-56, 66-67, and 77-78, while Eggleston does disclose tracking data associated with each of a plurality of gifts (Fig.20, C8 L13-20, C31 L25-67, C32 L1-20),

Hunter and Eggleston fail to expressly disclose wherein the data includes at least one of cost and supplier, quantity in stock.

20. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation awards would be performed regardless of the type of award/gift data tracked. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have tracked a plurality of award/gift data to include: included a plurality of innovator classes, to include: cost and supplier, quantity in stock, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

22. As per Claims 57, 60-63, 68, 71-74, 79, and 82-85, Hunter and Eggleston fail to expressly disclose tracking the number of innovation disclosures processed during the specific time period, data associated with an innovation award distributed upon submission of the innovation disclosure associated with the innovation award, data associated with an innovation award distributed upon issuance of the intellectual property asset associated with the innovation award, an innovation award distributed upon publication of data described in the innovation disclosure, and/or data associated with an innovation award distributed upon publication of data described in the innovation disclosure.

23. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation awards would be performed regardless of the type of innovation information was tracked. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have tracked a plurality of innovation associated information, to include: the number of innovation disclosures processed during the specific time period, data associated with an innovation award distributed upon submission of the innovation disclosure associated with the innovation award, data associated with an innovation award distributed upon issuance of the intellectual property asset associated with the innovation award, an innovation award distributed upon publication of data described in the innovation disclosure, and/or data associated with an innovation award distributed upon publication of data described in the innovation disclosure, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

25. As per Claims 59, 70, and 81, Hunter and Eggleston fail to expressly disclose storing IP coordinator contact data, the IP coordinator associated with an innovator.

26. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation awards would be performed regardless of the type of innovation information was stored. Thus,

this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have stored a plurality of innovation associated information, to include: innovator associated IP coordinator contact data, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

28. As per Claims 87-90, 93-96, and 99-102, Hunter and Eggleston fail to expressly show wherein the plurality of innovator classes includes the class of employees of the organization, the class of non-employees of the organization, or the class of contractors of the organization.

29. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator class used. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

30. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a plurality of innovator classes, to include: the class of employees of the organization, the class of non-employees of the organization, or the class of contractors of the organization, because such data does not functionally relate to

the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

31. As per Claims 91, 97, and 103, while Hunter does disclose storing organization data associated with the innovator (Para0109, type of originator), Hunter and Eggleston fail to expressly show the organization data related to the innovator and including at least one of affiliate organization, company, division, and business unit.

32. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator descriptive data used. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a innovator descriptive data (organization al date) to include: at least one of affiliate organization, company, division, and business unit, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

34. Applicant's arguments filed 11/2/05 have been considered, but are moot in view of the new ground(s) of rejection.

Conclusion

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

37. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

January 20, 2006

Jonathan Ouellette
Patent Examiner
Technology Center 3600